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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,390	05/05/1999	HIROAKI YAMAMOTO	06501/030001	2057

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FISH & RICHARDSON PC
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BOSTON, MA 02110

EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/305,390	YAMAMOTO, HIROAKI	
	Examiner	Art Unit	
	Richard G Hutson	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10,12,14,23 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10,12,14,23 and 28-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants amendment of claims 8 and 23, Paper of 9/16/2003, is acknowledged.
Claims 7-10, 12, 14, 23, 28-42 are still at issue and are present for examination.

Claim Objections

Claim 7 is objected to because of the following informalities:

Claim 7 recites "... comprising asymmetrically reducing a 4-halo-acetoacetic acid ester or its derivative...", whereas many of the claims which depend from claim 7 recite "said 4-haloacetoacetic acid ester".

It is suggested that applicants maintain consistency throughout the application, in referring to "4-haloacetoacetic acid ester.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-10, 12, 14, 23 and 28-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly claim the subject matter which applicant regards as the invention.

Claims 7 (8-10, 12, 14, 23, 28-42 dependent from) are indefinite in the recitation "a purified acetoacetyl-CoA reductase that can participate in a poly- β -hydroxy fatty acid biosynthesis system". The original claims refer to those "acetoacetyl-CoA reductase

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constituting the poly- β -hydroxy fatty acid biosynthesis system” and the specification on page 13, line 10 through page 14 describes those acetoacetyl-CoA reductase participating in PHA biosynthesis, and the specification lists a number of characteristics of such acetoacetyl CoA reductases such as comprises a tetramer of the subunit with a MW 20,000 to 40,000 etc... Thus, given this original description and applicants amendment of claim 7, it is unclear if those acetoacetyl-CoA reductase that “**can participate**” in a poly- β -hydroxy fatty acid biosynthesis system encompasses a different genus than those originally described in the specification as “**participating**” in PHA biosynthesis.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 12, 14, 28, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, written description, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claims are drawn to methods for producing (S)-4-halo-3-hydroxybutyric acid ester comprising using a purified acetoacetyl-CoA reductase comprising the amino acid sequence of a naturally occurring acetoacetyl-CoA reductase.

The Court of Appeals for the Federal Circuit has recently held that a "written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as be structure, formula [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *University of California v. Eli Lilly and Co.*, 1997 U.S. App. LEXIS 18221, at *23, quoting *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) (bracketed material in original). To fully describe a genus of genetic material, which is a chemical compound, applicants must (1) fully describe at least one species of the claimed genus sufficient to represent said genus whereby a skilled artisan, in view of the prior art, could predict the structure of other species encompassed by the claimed genus and (2) identify the common characteristics of the claimed molecules, e.g., structure, physical and/or chemical characteristics, functional characteristics when coupled with a known or disclosed correlation between function and structure, or a combination of these.

In the instant specification, an acetoacetyl-CoA reductase is fully described in the form of SEQ ID NO:1. This description also adequately describes a genus, within the of the claimed methods of use of acetoacetyl-CoA reductases. Those sequences that are "naturally occurring" are a subset of this genus. The specification does not adequately describe this subset according to its structure so that one of skill in the art would be able to predict naturally occurring sequences, particularly in view of the larger genus that includes both naturally and "manufactured" sequences. Therefore, the instant claims are not adequately described.

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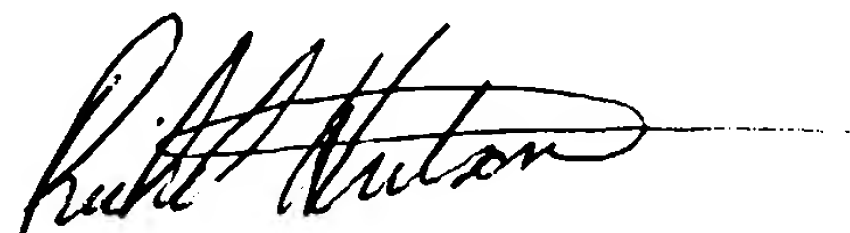
Further, claims 7, 12, 14, 28, 32 and 33 fail to describe the subgenus of those acetoacetyl-CoA reductases that "can participate in a poly- β -hydroxy fatty acid biosynthesis system". The specification does not adequately describe this subset according to its structure so that one of skill in the art would be able to predict those acetoacetyl-CoA reductases that "can participate in a poly- β -hydroxy fatty acid biosynthesis system. Therefore, the instant claims are not adequately described.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Richard G. Hutson", with a long horizontal line extending to the right.

Richard G Hutson, Ph.D.
Primary Examiner
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